

Application No. 10/702,194

REMARKS

Applicants' representatives would like to thank Supervisory Primary Examiner Tatyana Zalukaeva for the conference call conducted on November 14, 2005. During that conference call, Examiner Zalukaeva indicated that Examiner Gibson should have considered claims 21-34 in the Office Action dated October 31, 2005, and should have either examined those claims or issued a restriction requirement directed to those claims. Pursuant to Examiner Zalukaeva's statement and M.P.E.P. §707.07(i), which requires each claim to be mentioned in each Office Action, Applicants hereby request the issuance of a second non-final Office Action in which claims 21-34 are considered.

Applicants note that the claim listing in the Preliminary Amendment dated October 10, 2005, erroneously failed to indicate that claims 1-15 and 20 were withdrawn from consideration. Accordingly, Applicants have provided a new complete claim listing at pages 2-9 of this paper.

During the November 14 conference call, Examiner Zalukaeva indicated that she was considering restricting out the newly submitted claims as being directed to a non-elected species. Applicants respectfully disagree. Elected claims 16-19 (Group III) are directed to a method of pumping food out a patients upper digestive system, and as such they are inherently directed to limiting the absorption of food, which is a way to achieve weight loss and treat obesity. Since claims 21-34 recites similar steps of extracting food from a patient's upper digestive system, those claims are directed to the same invention as claims 16-19, and the new claims are "but different definitions of the same disclosed subject matter [that vary only] in breadth or scope of definition." M.P.E.P § 806.03. As such, restriction therebetween would be improper. *Id.*

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Moreover, the inventions defined by claims 21-34 are connected in the design, operation and effect to the same invention that is defined by claims 16-19, because both those sets of claims are directed to removing food from a patient's digestive system. Those two sets of claims are therefore not "independent" as that term is defined in MPEP § 802.01 and restriction therebetween is therefore improper for this additional reason.

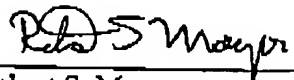
Finally, M.P.E.P. § 806.04(e) emphasizes that "*claims are never species*" and that "*species are always the specifically different embodiments.*" *Id.* (emphasis in original). New claims 21-34 are directed to the same embodiment as claims 16-19 because they all relate to the same process of pumping food out of the patient's upper digestive system. Since M.P.E.P. § 806.03 states that "[w]here the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction requirement therebetween should never be required," yet another reason exists why a restriction between those two sets of claims would be improper.

Accordingly, Applicants respectfully request consideration of claims 21-34 and the issuance of a new, non-final Office Action. If, despite the arguments presented above, the Examiner maintains that restriction is proper, Applicants request an indication to that effect in a new Office Action so that Applicants can file an appropriate Petition.

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If the Examiner has any questions, the Examiner is invited to call Applicants' representative directly at (212) 969-3000.

Respectfully submitted,
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